## REMARKS

Claims 1–21 are pending in the present application.

Claims 1–2, 10 and 17–18 were amended.

Claims 21 was added.

Reconsideration of the claims is respectfully requested.

### 35 U.S.C. § 103 (Obviousness)

Claims 1–5, 7–13 and 15–20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,392,452 to *Davis* in view of U.S. Patent No. 6,259,892 to *Helferich*. Claims 6 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Davis* in view of *Helferich* and further in view of U.S. Patent No. 5,742,905 to *Pepe et al.* These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does

not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

*Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself

suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781,

783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach

or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and

the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. MPEP § 2142.

Independent claims 1, 10, and 18 each recite that the data record for messages directed to the

subscriber includes at least one message which was previously delivered to the subscriber. That is,

the database includes messages which have been delivered as well as messages received for delivery

but not yet delivered. Such a feature is not shown or suggested by the cited references. *Davis*

discloses a system for delivering messages in which messages having a length longer than a

predetermined message length 112 (e.g., lengthy messages or messages with attachments) are queued

in temporary message memory 42 for delivery to a special combination pager and cordless telephone

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40 when retrieval is requested by the user, with a page being transmitted at the time the message is stored with a predetermined message 124 notifying the subscriber of the stored message. *Davis*, column 4, lines 3–21. Upon receiving an authorized retrieval request, the stored message is transmitted in its entirety to the combination pager and cordless telephone 40 and is then erased from the temporary memory 42. *Davis*, column 4, lines 22–59. *Davis* thus teaches storing only messages which have not yet been delivered to the subscriber, and only messages which are lengthy and/or accompanied by attachments. *Davis* does not teach or suggest storing messages which were previously delivered to the subscriber, but instead explicitly teaches deleting stored messages upon successful delivery.

Similarly, *Helferich* teaches storing messages to be delivered to the paging transceiver 100 and transmitting an alert to the paging transceiver, then allowing the user to retrieve the message, store the message at either the delivery system 30 or the transceiver 100, forward or reply to the message or erase the message. *Helferich*, column 14, line 59 through column 15, line 5. By transmitting an alert regarding the message rather than the entire message, the user is enabled to retrieve only selected messages from the stored messages to be delivered to the paging transceiver 100. *Helferich*, column 15, lines 28–33. However, *Helferich* does not teach or suggest storing a message already transmitted to paging transceiver 100 and transmitting information regarding such stored, delivered messages to the paging device 100.

Moreover, the combination of *Davis* and *Helferich* fails to achieve the claimed invention because neither reference, taken alone or in combination, teaches or suggests storing delivered

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messages <u>and</u> sending information regarding such stored, delivered messages to the subscriber upon request. Both *Davis* and *Helferich* teach only sending of information regarding stored, <u>undelivered</u> messages to the user.

*Pepe et al* similarly fails to teach or suggest the claimed invention of independent claims 1, 10 and 18, taken alone or in combination with *Davis* or *Helferich*. *Pepe et al* discloses a system for delivering wireless messages to a PDA in which messages which are currently undeliverable (i.e., the PDA is out of radio range or not registered) are sent to external storage. *Pepe et al*, column 19, lines 30–36. When retrieving <u>undelivered</u> messages from the external storage, the PDA initiates a fetch which results in the undelivered messages being <u>moved</u> from the storage to a "pending area." *Pepe et al*, column 19, lines 46–64. *Pepe et al* does not teach or suggest continuing storage of messages which have already been delivered to a subscriber, or transmission of information regarding stored, delivered messages to the subscriber.

Claims 2 and 17 recite automatically storing messages which were delivered (or at least the subject of a delivery attempt) within the data record for the subscriber for subsequent availability to the subscriber. That is, each message is stored in the database <u>after</u> RF transmission of the message to the paging device (regardless of whether RF transmission is successfully received by the paging device). Such a feature is not shown or suggested by the cited references. *Davis* teaches that only messages exceeding a predetermined length are stored, and those messages are stored prior to transmission to the combination pager cordless telephone 40, not <u>after</u> RF transmission. *Pepe et al* teaches storing (only) undelivered messages, which necessarily involves storing those messages prior

to transmission. *Helferich* teaches storage of messages pending delivery and user-controlled storage or erasure of undelivered messages, but does not teach or suggest automatic storage of all messages after delivery to the subscriber.

Claim 9 (and newly added claim 21) recites that the message retrieval request originates from a device other than the paging device for the subscriber such as a landline telephone or computer.. Such a feature is not shown or suggested by the cited references. The cited portion of *Davis* teaches that a message retrieval request is received by paging terminal 32 through interface 30, but also teaches that the message retrieval request originates with the combination pager/telephone, not with a device other than the combination pager/telephone.

Therefore, the rejection of claims 1–20 under 35 U.S.C. § 103 has been overcome.

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## AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

Claims 1–2, 10 and 17–18 were amended herein as follows:

1        1. (three times amended)  For use in a wireless messaging system, a message distribution

2        system capable of allowing a subscriber of said wireless messaging system to review stored wireless

3        messages sent to said subscriber comprising:

4        a first I/O interface capable of receiving, from said subscriber, a message retrieval

5        request for messages directed to said subscriber;

6        a message retrieval controller coupled to said first I/O interface capable of

7        determining an identity of said subscriber from identification data contained

8        in said message retrieval request,

9        accessing a data record associated with said subscriber, said data record

10        containing one or more of said stored wireless messages directed to said subscriber including

11        at least one stored message which was previously delivered to said subscriber, and

12        transferring to said subscriber selected review information from said data

13        record related to [at least]a group of one or more of said stored wireless messages [within

14        said data record]including said at least one stored message which was previously delivered

15        to said subscriber.

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1     2. (three times amended)  The message distribution system set forth in Claim 1 further

2     comprising an interface to a database coupled to said message distribution system and storing

3     wireless messages which are directed to said subscriber independent of whether said wireless

4     messages have been delivered to said subscriber, wherein each wireless message directed to said

5     subscriber is automatically stored in said database after transmission of said wireless message for

6     reception by a paging device for said subscriber, regardless of whether said wireless message was

7     received by said wireless paging device.

1    10. (three times amended)  A wireless messaging system comprising:

2            a plurality of RF transceiver facilities capable of transmitting and receiving wireless

3    messages to and from paging devices used by subscribers of said wireless messaging system;

4            a message distribution system capable of allowing a subscriber of said wireless

5    messaging system to review stored wireless messages sent to said subscriber comprising:

6                    a first I/O interface capable of receiving, from said subscriber, a message

7            retrieval request for messages directed to said subscriber; and

8                    a message retrieval controller coupled to said first I/O interface capable of

9            determining an identity of said subscriber from identification data contained in said

10            message retrieval request, accessing a data record associated with said subscriber,

11            said data record containing one or more of said stored wireless messages directed to

12            said subscriber including at least one stored message which was previously delivered

13            to said subscriber, and transferring to said subscriber selected review information

14            from said data record relating to [at least]a group of one or more of said stored

15            wireless messages[ within said data record]including said at least one stored message

16            which was previously delivered to said subscriber; and

17                    a database coupled to said message distribution system storing said stored wireless

18    messages.

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1       17. (amended) The message distribution system set forth in Claim 10 wherein each wireless

2     message directed to said subscriber is automatically stored in said database after RF transmission

3     of said wireless message for reception by a paging device for said subscriber, regardless of whether

4     said wireless paging device receives said wireless message.


1       18. (three times amended) For use in a wireless messaging system, a method for allowing

2     a subscriber of the wireless messaging system to view on a display device stored wireless messages

3     sent to the subscriber comprising the steps of:

4          receiving a message retrieval request from the subscriber for wireless messages

5     directed to the subscriber;

6          determining an identity of the subscriber from identification data contained in the

7     message retrieval request;

8          accessing a data record associated with the subscriber, the data record containing one

9     or more of the stored wireless messages directed to the subscriber including at least one stored

10    message which was previously delivered to said subscriber; and

11         transferring to said subscriber selected review information relating to [at least]a group

12    of one or more of the stored wireless messages [to the subscriber]including the at least one stored

13    message which was previously delivered to said subscriber.

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